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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,900	08/17/2005	Manfred Malle	5696.P0002US	2982
23474 7590 05/02/2008 FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631				
EXAMINER				
LUONG, VINH				
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3682				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,900

Applicant(s)

MALLE, MANFRED

Examiner

Vinh T. Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Individual Patent Application
- 6) ☒ Other: Attachment
- Paper No(s)/Mail Date _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 28, 2007 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 2-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms, such as, “movable” in Claim 13, “engageable,” “may be detached,” and “movable” in Claims 14 and 15 are vague and indefinite in the sense that things which may be done are not required to be done. For example, in Claims 14 and 15, the detent element is engageable, but is not required structurally to be engaged against spring force. See “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “crimpable” in *Application of Collier*, 158 USPQ 266 (CCPA 1968), “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

It is unclear whether:

(a) a confusing variety of terms, such as, “bicycles” (plural, emphasis) and “a bicycle” (singular, emphasis) in Claims 13-15 refers to the same or different things. See MPEP 608.01(o) and double inclusion in MPEP 2173.05(o); and

(b) the term that appears at least twice, such as, “a shoe” in Claim 12/11/10/4/3/13 refers to the same or different things. See double inclusion in MPEP 2173.05(o).

4. Claims 2-7 and 9-15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Lyotard (FR 2624470).

Regarding Claim 13, as noted from the translation attached, Lyotard teaches a pedal system for bicycles with a shoe insert 1 configured to a shoe (Att.) and including a detent element $1g^1$, $1g^2$, and with a pedal 4 that is configured to attach to a bicycle and is rotatably mounted on a pedal axle 3, and has a seat 4c, 7 for the detent element $1g^1$, $1g^2$, in which the detent element $1g^1$, $1g^2$ is engaged against a spring force 8 and from which the detent element $1g^1$, $1g^2$ is capable of being detached by performing a rotating movement, wherein the seat 4c, 7 is conformed between two seat parts 4c and 7 that are constructed rotationally symmetrically about the pedal axle 3, and which are *movable* away from each other along the pedal axle 3 against said spring force 8, and are components of sleeves 4 and 7 with cylindrical external surfaces (FIG. 8), wherein the detent element $1g^1$, $1g^2$ is an elongated part (FIGS. 5 and 6) that extends perpendicularly to the pedal axle 3 (FIG. 3) when engaged, and has two cams 1f (FIGS. 5 and 6) which clasp below the seat parts 4c and 7 in the engaged position (FIGS. 2 and 4), and the shoe insert 1 has a control element 1a (FIGS. 2-5) which is forced against the cylindrical external surfaces of the sleeves 4 and 7 in such a manner that when the shoe insert 1 is rotated to release the detent element $1g^1$, $1g^2$, the detent element $1g^1$, $1g^2$ is raised (FIG. 7).

Regarding Claim 2, the seat parts 4c and 7 comprise receiving grooves 4c and 7c (Att.) facing one another.

Regarding Claim 3, one (7) of the two seat parts 4c and 7 is displaced against said spring force 8.

Regarding Claim 4, one of the seat parts is part of a first sleeve 4c, 4d which is supported rotatably with respect to the pedal axle 3, and the other seat part 7 is part of a second sleeve 7, which is supported movably on the first sleeve 4c, 4d (FIG. 2).

Regarding Claim 5, the first sleeve 4c, 4d is non-movable with respect to the axis (Att.) of the pedal 4, and the second sleeve 7 is movable against said spring force 8.

Regarding Claim 6, at least one compression spring 8 provides said spring force, which compression spring 8 is supported at a first end on an abutment (Att.) operatively connected to the first sleeve 4c, 4d and at a second end (Att.) on the second sleeve 7.

Regarding Claim 7, the first sleeve 4c, 4d is supported rotatably by means of ball bearings CB on the pedal axle 3.

Regarding Claim 9, the detent element $1g^1$, $1g^2$ has side surfaces, which have centrally each one cam 1f (FIGS. 5 and 6).

Regarding Claim 10, said control element 1a acts centeringly with respect to the seat 4c, 7 of the pedal 4.

Regarding Claim 11, the control element 1a has supporting wings 1c, 1d (Att.) extending laterally of the detent element $1g^1$, $1g^2$, the insides of which supporting wings 1c, 1d (Att.) come into contact or are in contact with outer surface areas of the sleeves 4c, 4d and 7, which outer surface areas extend cylindrically and rotationally symmetrically with respect to the pedal axis (Att.), and are curved with a radius (at 1f in FIG. 4), which is smaller than the radius of the outer surfaces of the sleeves 4c and 7 as seen in FIG. 4.

Regarding Claim 12, the control element 1a (Att.) is connected to a shoe (Att.).

Regarding Claim 14, Lyotard teaches a pedal system for bicycles with a shoe insert 1 that is configured to attach to a shoe (Att.) and has a detent element $1g^1$, $1g^2$, and with a pedal 4 that is configured to attach to a bicycle and is rotatably mounted on a pedal axle 3, and has a seat 4c, 7 for the detent element $1g^1$, $1g^2$, in which the detent element $1g^1$, $1g^2$ is engageable against spring force 8 and from which the detent element $1g^1$, $1g^2$ *may be* detached by performing a rotating movement, wherein the seat 4c, 7 is conformed between two seat parts 4c and 7 that are constructed rotationally symmetrically about the pedal axle 3, and which are movable away from each other towards the pedal axle 3 against spring force 8, and are components of sleeves 4c, 4d and 7 with cylindrical external surfaces (FIG. 8), wherein the detent element $1g^1$, $1g^2$ is an elongated part that extends perpendicularly to the pedal axle 3 when engaged, and has two cams 1f which clasp below the seat parts 4c and 7 in the engaged position, and wherein the shoe insert 1 includes a control element 1a comprising two wings 1e, 1d (Att.) situated on the external surfaces of the sleeves 4c, 4d and 7 when the detent element $1g^1$, $1g^2$ is engaged, and which is forced against the cylindrical outer surfaces of the sleeves 4c, 4d and 7 in such a manner that when the shoe insert 1 is rotated to release the detent element $1g^1$, $1g^2$, the detent element $1g^1$, $1g^2$ is raised as seen in FIG. 7.

Regarding Claim 15, Lyotard teaches a pedal system for bicycles with a shoe insert 1 that is configured to attach to a shoe (Att.) and including a detent element $1g^1$, $1g^2$, and with a pedal 4 that is configured to attach to a bicycle and is rotatably mounted on a pedal axle 3, and has a seat 4c, 7 for the detent element $1g^1$, $1g^2$, in which the detent element $1g^1$, $1g^2$ is engageable against spring force 8 and from which the detent element $1g^1$, $1g^2$ *may be* detached by

performing a rotating movement (FIG. 7), wherein the seat 4c, 7 is conformed between two seat parts 4c and 7 that are constructed rotationally symmetrically about the pedal axle 3, and which are movable away from each other towards the pedal axle 3 against spring force 8, and are components of sleeves 4c, 4d and 7 with cylindrical external surfaces (FIG. 8), wherein the detent element $1g^1$, $1g^2$ is an elongated part that extends perpendicularly to the pedal axle 3 when engaged, and has two cams 1f which clasp below the seat parts 4c and 7 in the engaged position, and wherein the shoe insert 1 includes a control element 1a having supporting wings 1e, 1d (FIG. 5 in Att.) extending *laterally* of the detent element $1g^1$, $1g^2$, the *insides* (at 1f in FIG. 5) of which supporting wings 1e, 1d (Att.) contacting said external surface areas (FIG. 8) of the sleeves 4c, 4d and 7, which external surface areas (FIG. 8) extend cylindrically and rotationally symmetrically with respect to a pedal axis (FIG. 2 of Att.), the supporting wings 1e, 1d (Att.) being curved (at 1f in FIG. 5) with a radius which is larger than the radius of the external surfaces (FIG. 8) of the sleeves 4c, 4d and 7, and wherein said wings 1e, 1d (Att.) of said control element 1a are forced against the cylindrical external surfaces (FIG. 8) of the sleeves 4c, 4d and 7 in such a manner that when the shoe insert 1 is rotated to release the detent element $1g^1$, $1g^2$, the detent element $1g^1$, $1g^2$ is raised.

5. Claims 2-15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyotard.

Regarding Claims 2-7 and 9-15, Lyotard teaches the invention as claimed except the manner or method in which the pedal system is used, e.g., “when the shoe insert is rotated to release the detent element, the detent element is raised” in Claims 13-15.

It is common knowledge in the art to use Lyotard's pedal system in such a manner that, e.g., when the shoe insert is rotated to release the detent element, the detent element is raised. The instant manner of use is notoriously well known in bicycle shoe cleat art as evidenced by, e.g., FIGS. 17-22 of US Patent No. 4,488,453 issued to Drugeon et al.; FIG. 7 of US Patent No. 4,686,867 issued to Bernard et al.; FIGS. 4-7 of US Patent No. 4,932,287 issued to Ramos; FIGS. 9-11 of US Patent No. 5,060,537 issued to Nagano; FIGS. 2 and 3 of US Patent No. 5,423,233 issued to Peyre et al.; and FIGS. 4-6 of US Patent No. 5,699,699 issued to Nagano.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Lyotard's pedal system in such a manner that, e.g., when the shoe insert is rotated to release the detent element, the detent element is raised. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself).

Regarding Claim 8, Lyotard's detent element $1g^1$, $1g^2$ is an elongated component which has a wedge-shaped designed area for positioning between the seat parts 4c, 4d and 7. *Ibid.* abstract.

It is common knowledge in the art to form the Lyotard's wedge-shaped design area having a tapered portion for facilitating the alignment of the detent element $1g^1$, $1g^2$ with the seat parts 4c, 4d and 7. The tapered portion of the wedge is notoriously well known as evidenced by, e.g., publications The Free Dictionary, Wedge (mechanical design), and Wedge attached to the Office action on September 24, 2007.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Lyotard's wedge-shaped design area having a tapered portion for

facilitating the aligning of the detent element with the seat parts as taught or suggested by common knowledge in the art. The modification of Lyotard's pedal system by changing the shape of Lyotard's detent element to wedge-shape would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

6. Applicant's arguments filed July 16, 2007 and December 28, 2007 have been fully considered but they are not persuasive.

35 USC 112

The Examiner respectfully submits that the amended claims are vague and indefinite as seen in the rejection above.

35 USC 102(b)

At the outset, Applicant stated that Applicant's prior response mailed on July 11, 2007 is incorporated herein in its entirety.

For completeness, the Examiner's response on July 11, 2007 is reiterated in the following.

First, Applicant contended:

Lyotard '470 therefore does not disclose that *the shoe insert is released by carrying out a rotating movement, as required by independent claim 1, or that the engaging element is raised when the shoe insert is rotated to release the engaging element, as required by new independent claim 13*. Lyotard '470 further does not disclose the detent element which has a tapered portion for aligning the detent element between the seat parts, as required by claim 8. *The "wedge" referred to in the abstract of Lyotard '470 is the common term for a shoe insert, and is not related*

to the actual shape of the detent element that facilitates alignment with seat parts according to the claimed invention. Lyotard '470 further does not disclose the supporting wings, the insides of which come into contact with outer surface areas of the sleeves which extend cylindrically and rotationally symmetrically with respect to the pedal axis, as required by claim 11. (Emphasis added).

It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then, it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963); *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997); and *Ex parte Smith*, 83 USPQ2d 1509 (BPAI 2007).

In the instant case, as noted, Lyotard's pedal comprises the fixed seat part 4 and the movable seat part 7. Therefore, in order to engage the shoe insert 1 with the pedal, the bicyclist inherently must rotate the foot as shown in Lyotard's FIG. 7 so that the bicyclist can slide the insert 1 into the space defined by the seats 4 and 7. In other words, the seat 7 must be moved in order to expand the space between the seats 4 and 7 to let the insert 1 slide therein. Similarly, when the bicyclist desires to disengage or release the insert 1 from the pedal, the bicyclist must raise one side of the insert 1 as seen in FIG. 7 so that the space between the seats 4 and 7 can be expanded to let the insert 1 get out. The instant mode of operation is notoriously well known in bicycle shoe cleat art as evidenced by the cited references above. Simply put, Lyotard's shoe insert and engaging/detent element inherently operate as claimed.

On the other hand, the Examiner is mindful that the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. *In re Danly*, 120 USPQ 528

(CCPA 1959) and MPEP 2114. Applicant does not claim patentable distinguishing structure(s) over Lyotard but tandem relies on the mode of use of the shoe insert or engaging element. Our reviewing Court in *Schreiber* stated that “Although *Schreiber* is correct that Harz does not address the use of the disclosed structure to dispense popcorn, the absence of a disclosure relating to function does not defeat the Board's finding of anticipation.” See also *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987). Hence, Applicant’s arguments above are unpersuasive.

With respect to Claim 8, Applicant stated: “the ‘wedge’ referred to in the abstract of Lyotard is the common term for a shoe insert, and is not related to the actual shape of the detent element that facilitates alignment with seat parts according to the claimed invention.”

However, Applicant did not cite any reference or evidence to support this statement. It is well settled that an expert’s opinion on the ultimate legal issue must be supported by some thing more than a conclusory statement. *In re Buchner*, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

In the instant case, the Examiner respectfully submits that the common term for the shoe insert is “a cleat,” not “a wedge.” See, e.g., the cleat 30 in US Patent No. 5,699,699 issued to Nagano. By using the term “wedge,” Lyotard implies a tapered portion as evidenced by ordinary and customary meaning of the term “wedge” in publications cited. Therefore, Lyotard implicitly teaches the tapered portion as claimed. Alternatively, common knowledge in the art would form the wedge of Lyotard having a tapered portion in order to facilitate the sliding of the shoe insert into and out of the detent element. Thus, Claim 8 is not patentable as mandated by *KSR, supra*.

Second, Applicant asserted:

Instead, Lyotard '470 discloses *a shoe insert* of the pedal system that *does not comprise a control element forced against cylindrical external surfaces of the sleeve* (elements 4C, 7 in Figure 7). Referring to Figures 1, 2, 7 and 8 of

Lyotard '470, the shoe insert 1 does not contact the external surfaces of the sleeves, nor does the shoe (shown in phantom) contact said sleeves. Furthermore, release of the shoe insert disclosed in Lyotard '470 requires that the shoe insert be moved parallel to the longitudinal axis of the pedal, parallel to the axle, in the direction of the arrow F3 in Figure 7. The shoe insert is then inclined, in the direction of the arrow F5 in Figure 7, to clear the sleeve 4C. No part of the shoe or shoe insert contacts the external surfaces of sleeves 4, 7. (Emphasis added).

The Examiner respectfully submits that FIGS. 1 and 2 show that the shoe insert 1 contacts the external surfaces of the sleeves. It is well settled that drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972).

On the other hand, Applicant's arguments regarding the shoe or the shoe insert being in contact with the external surface of the external surfaces of the sleeves are not based on the limitations appearing in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As noted, it is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "fully met" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983).

In the instant case, Claims 13-15 broadly recites "the shoe insert has a control element which is *forced against* the cylindrical external surfaces of the sleeves." Applicant's claims do not preclude the control element of the shoe insert being indirectly or operatively forced against

the external surfaces of the sleeves. Therefore, assuming *arguendo* that no part of Lyotard's shoe or shoe insert directly contacts the external surfaces of sleeves 4, 7, Applicant's claims still are "fully met" by Lyotard.

Third, Applicant alleged:

Further, Lyotard '470 does not include a control element comprising wings situated on the external surfaces of the sleeves when the detent element is engaged, as required by claim 14. Lyotard '470 further does not disclose the control element having supporting wings extending laterally of the detent element, the insides of which supporting wings contact said external surface areas of the sleeves, as required by claim 15.

The Examiner respectfully submits that Applicant apparently uses an "*ipsissimis verbis*" test that requires the same terminology in the prior art reference in order to find anticipation. See footnote 11 of *AKZO N.V. v. International Trade Commission*, 1 USPQ2d 1241, 1245 (CAFC 1986). It is well settled that an inventor can be his/her own lexicographer. Thus, Lyotard does not need to use the same terminology as Applicant uses.

More importantly, it is well settled that an anticipatory reference needs not duplicate word for word what is in the claims. Anticipation can occur when a claimed limitation is "inherent" or otherwise implicit in the relevant reference. *Standard Haven Products Inc. v. Gencor Industries, Inc.*, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991).

In the case at hand, Lyotard's FIG. 5 shows that the control element 1 comprising two curved surfaces 1d, 1e situated on or contact with the external surfaces of the sleeves 4c, 4d when the detent element 1g¹, 1g² is engaged with the sleeves 4c, 4d as seen in FIGS. 1 and 2 and described on page 6 of the translation. Hence, the surfaces 1d, 1e "read on" the claimed wings.

For the foregoing, the Examiner respectfully declines Applicant's request to put this case in the condition for allowance.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Vinh T Luong/
Primary Examiner, Art Unit 3682